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10/589,081	01/10/2007	Ramon Rodriguez Cuartas	293703US0PCT	5870

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EXAMINER	
BELYAEV, YANA	
ART UNIT	PAPER NUMBER
1741	

NOTIFICATION DATE	DELIVERY MODE
04/06/2012	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Advisory Action Before the Filing of an Appeal Brief	**Application No.** *10/589,081*	**Applicant(s)** RODRIGUEZ CUARTAS ET AL.
	Examiner YANA BELYAEV	**Art Unit** 1741

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 March 2012 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

NO NOTICE OF APPEAL FILED

1. ☒ The reply was filed after a final rejection. No Notice of Appeal has been filed. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114 if this is a utility or plant application. Note that RCEs are not permitted in design applications. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires *3* months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action; or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
   c) ☐ A prior Advisory Action was mailed more than 3 months after the mailing date of the final rejection in response to a first after-final reply filed within 2 months of the mailing date of the final rejection. The current period for reply expires months from the mailing date of *the prior Advisory Action* or SIX MONTHS from the mailing date of the final rejection, whichever is earlier.

   Examiner Note: If box 1 is checked, check either box (a), (b) or (c). ONLY CHECK BOX (b) WHEN THIS ADVISORY ACTION IS THE FIRST RESPONSE TO APPLICANT'S FIRST AFTER-FINAL REPLY WHICH WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. ONLY CHECK BOX (c) IN THE LIMITED SITUATION SET FORTH UNDER BOX (c). See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) or (c) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendments filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   b) ☐ They raise the issue of new matter (see NOTE below);
   c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): (a) ☐ will not be entered, or (b) ☐ will be entered, and an explanation of how the new or amended claims would be rejected is provided below or appended.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing the Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

STATUS OF CLAIMS

14. The status of the claim(s) is (or will be) as follows:

    Claim(s) allowed: .
    Claim(s) objected to: .
    Claim(s) rejected: 1-14 and 19-21.

Claim(s) withdrawn from consideration: 15-18.

/Matthew J. Daniels/ Supervisory Patent Examiner, Art Unit 1741	

Continuation of 11. does NOT place the application in condition for allowance because:
The Applicant argues that the Speit process as described at the bottom of col. 8 does not involve the float glass method, but pouring a bubble-free melt into a mold. Thus, the Applicant concludes, Speit is not pertinent to the presently claimed float glass process.

The Examiner agrees that Speit does not involve the float glass method, but respectfully disagrees that Speit is not pertinent to the presently claimed invention. Speit is relied upon to teach glass which comprises 24-46 % by weight of lead oxide (col. 3, line 68), which is a known glass composition.

The Applicant argues that the Examiner has improperly construed col. 3, line 24 of Blackburn, which describes a composition containing "about 1 to about 25 weight percent PbO", as encompassing glass containing "at least 30% lead oxide" as required by claim 1.
The Examiner respectfully disagrees. A prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. Titanium Metals Corp. of America v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).
The Applicant argues that neither Blackburn nor Speit suggests that flat window panes comprising 24 to 46% lead oxide can be produced by the float glass method of Blackburn. The Applicant argues that the Examiner has not pointed out any suggestion in either reference for applying a float glass method to making glass containing at least 30% lead oxide or shown that these references would have provided a reasonable expectation of success for the process of the invention which solves fouling problems associated with prior art float glass processes as disclosed on pages 2-3 of the specification.

The Examiner respectfully disagrees. The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. See, e.g., In re Kahn, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). Thus, the Examiner's position is that it would have been obvious to one of ordinary skill in the art at the time of the invention to have made the flat window disclosed by Speit by the float glass process disclosed by Blackburn for glass sheets comprising from 1 to about 25 percent lead oxide. The motivation to do so would have been the rationale that a float glass process is a well known method in the art to form a glass sheets. It would have also been known to one of ordinary skill in the art at the time of the invention to have applies the float glass process to form glass sheets comprising 1 to about 25 weight percent lead oxide, as disclosed by Blackburn. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have applied the method for forming glass sheets comprising 1 to about 25 weight percent lead oxide disclosed in Blackburn to forming flat window panes comprising 24 to 46 percent by weight lead oxide, as disclosed by Speit.

The Applicant argues that Loukes discloses both reducing and non-reducing atmospheres in col. 3, but does not teach that selection of a non-reducing atmosphere would solve the fouling problems associated with making a float glass containing at least 30% lead oxide. The Applicant further argues that no prima facie case has been established because there is no suggestion in the prior art to float glass containing at least 30% lead oxide on a bath of molten tin and no expectation that doing so under a neutral gas atmosphere would resolve the fouling problems associated with the used of a reducing atmosphere as disclosed in the paragraph bridging pages 2-3 of the specification.

The Examiner respectfully disagrees. The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. See, e.g., In re Kahn, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

The Applicant argues that US Patent 4,015,966 provides futher evidence of why one of ordinary skill in the art would not have had a reasonable espectation of success for such a process. The Applicant states that at col. 2, line 15 and in claim 1 it discloses compositions without lead (Pb) and explains that "the use of lead oxide (col. 1, line 32) in glass compositions implies the following problem: "While these X-rays absorbing glass compositions can be melted and formed by conventional techniques, a problem can somtimes arise in the form of surface discoloration wherein such X-ray absorbing compositions are melted by a process where in the glass in the molten state is supported or floated on a bath of molten metal such as molten tin," col. 1, lines 58-64. To solve this problem the "molten glass is floated on a bath of molten tin, wherein said X-ray absorbing glass composition is free of the oxides of lead," col. 2, lines 13-15. Thus, this prior art teaches away from floating a glass rich in lead by suggesting that lead be omitted from the float composition. The Appplicant concludes that this rejection cannot be sustained because none of the prior art suggests a float glass process that floats a ribbon of glass containing at least 30% lead oxide, nor does it provide a reasonable expectation of success for such a process.

The Examiner respectfully disagrees. US Patent 4,015,966 fails to teach away from floating a glass rich in lead. Simply because sometimes a problem can arise in the form of a surface discoloration when X-ray absorbing compositions are melted by a process where in the glass in the molten state is supported or floated on a bath of molten metal such as molten tin, is not sufficient for a teaching away. Furthermore, Blackburn discloses a neutron absorbing glass sheet which comprises from about 1 to about 25 weight percent lead oxide (col. 3, line 24) and is formed using a float glass process similar to that employed to form conventional commercial glass as is well known in the art (col. 3, lines 59-62). Therefore, it is well known to use glass containing lead oxide in a float glass process.

The Applicant argues that the Examiner alleges that substituting a glass ribbon containing 60% lead oxide for Blackburn's glass that contains about 1 to about 25% lead oxide is a simple substitution of one known element for another. The Applicant argues that, however, the Examiner points out no teaching, suggestion or motivation in the prior art for making such a substitution or for asserting the equivalence of glass ribbons containing different amounts of lead oxide. The Applicant argues that those of ordinary skill in the art would have reasonably expected that lead oxide content would affect the properties of a glass ribbon in a float glass process due to the different

chemical nature of the glass as well as the different density of glasses containing different amounts of lead oxide. The Applicant argues that the Examiner has not established any reason why one of ordinary skill in the art would have considered glasses containing significantly different amounts of lead oxide to be functional equivalents within a float glass process.

The Examiner respectfully disagrees. The rationale to support a conclusion that the claim would have been obvious is that the substitution of one known element for another yields predictable results to one of ordinary skill in the art (see MPEP 2143 B). Furthermore, "Express suggestion to substitute one equivalent for another need not be present to render such substitution obvious." Id. at 301, 213 USPQ at 536. "Obviousness does not require absolute predictability of success." Id. at 903, 7 USPQ2d at 1681.

The Applicant argues that claims 15-18, to any extent considered to lack unity, should be rejoined and allowed with examined method claim 1 from which they now all depend. These claims were deemed to lack unity on the ground that the special technical feature "comprising at least 30% lead oxide by weight" lacked novelty. However, these method claims have been amended to depend from claim 1 and thus intrinsically share its general inventive concept and unique special technical features, see MPEP 1893.01(d).

The Examiner respectfully disagrees. Lack of unity of invention may be directly evident "a priori," that is, before considering the claims in relation to any prior art, or may only become apparent "a posteriori," that is, after taking the prior art into consideration. If it can be established that a single feature or a group of features common to both independent claims is known, then there is lack of unity a posteriori, since the single feature or group of features common to both independent claims is not a technical feature that defines a contribution over the prior art (see MPEP 1850 (II))..